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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/533,361	03/22/2000	Beatrice Toumi	6388-0501-0	9261
22850 7590 01/14/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER YU, GINA C	
			ART UNIT 1617	PAPER NUMBER
			NOTIFICATION DATE 01/14/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

### Application No.

09/533,361

### Applicant(s)

TOUMI ET AL.

### Examiner

Gina C. Yu

### Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,17-22 and 24-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,17-22 and 24-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 16, 2007 has been entered.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1, 3, 17-22, 24-49 are rejected as unpatentable under 35 U.S.C. § 103 (a) over Fox (US 5879684) in view of Kumar et al. (US 5468477).**

Fox teaches a method to eliminate wrinkles and tighten skin by topically applying a gel composition comprising Vegetensor, a plant protein complex, and algal extract. See col. 2, lines 50 – 67. See instant claims 21, 22, 35, and 20. The protein complex is said to be “filmogeneous and is well suited to use in creams, lotions, and the like”. See Id. The reference further teaches, “[o]nce applied, the dried product retracts, thereby lending the tensor, or skin tightening, effect”. See Id. The reference teaches using the composition on the areas where signs of aging show earliest. See col. 7, lines 34 – 48.

While Fox teaches using a film-forming agent (hydroxyethyl methacrylate homopolymers) that is water impermeable and highly pliable, the reference fails to teach the grafted polymethylsiloxanes of instant formula (IV).

Kumar discloses in Example 27 a face cream composition comprising 2 % by weight of the vinyl-silicone graft polymer of the instant claims. See also col. 4, line 50 – col. 6, line 16; instant claims 48 and 49. In the mercapto functional silicone compound shown in col. 8, line 30 – col. 9, line, when R1, G5, and G6 of the Kumar polymer is C1-4 alkyl, the prior art meets G1 of instant formula (IV); R2 and R4 of tge Kumar polymer being C1-10 alkylene meets G2 of instant formula (IV) when  $n = 1$ ; G2 and G2 of the prior art is vinyl polymeric segments consisting essentially of polymeric free radically polymerizable monomer, meet G3 and G4 of instant claim. Example 2 teaches copolymer using mercapto functional silicone (PS850), acrylic acid (anionic monomer of G3 of instant claim) and n-butyl methacrylate (hydrophobic monomer of G4 of instant claim). The reference teaches that the polymer is used in cosmetics having active ingredients such as “skin-improvers”. See col. 25, lines 10-29. The vinyl-silicone copolymers are used to make a gel composition, and said to also have “excellent film-forming capability”, exhibiting a superior water-resistance, oil-resistance, and other characteristics required for cosmetic films”. See col. 17, line 52 – col. 18, line 24. The reference also teaches using preferably 0.2-30 % by weight of vinyl-silicone copolymer to realize the desired cosmetic film property. See col. 43—50. See also col. 17, lines 56-66; col. 19, lines 4-13. See instant claims 19, 25, 26, and 31-33. Kumar further suggests that the grafted vinyl-silicone copolymer gives a good adhesion to a substrate

and retains its shape-retention property in virtue of the hard monomers which renders the grafted copolymers tensile strength. See col. 15, line 47- col. 16, line 14; col. 18, lines 19-64. See also col. 19, lines 14 – 21 which teaches that cosmetic composition comprising the said silicone graft copolymer produces improved water-resistance and produces a "thick-film sensation" after the application.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of Fox by substituting the film-forming agent with the vinyl-silicone graft polymers of Kumar et al. because the latter teaches that the vinyl-silicone polymer renders "excellent film-forming capability", superior resistance to water and oil, "thick-film sensation" and otherwise suitable for cosmetic films. The skilled artisan would have had a reasonable expectation of successfully producing a skin tightening composition with superior or equivalent film-forming effect on the skin because both Fox and Kumar teach making cosmetic gel, lotion, and cream formulations.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claim 34 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 16, 27-29 of U.S. Patent No. 6022836.**

'836 claims a detergent hair composition comprising at least one cationic polymeric conditioning agent and at least one water-soluble or -dispersible silicone compound including a silicone main chain onto which at least one hydrocarbon group of anionic nature is grafted. See '836, claims 1 and 16. The said silicone compound is present in a weight content ranging from 0.05-10 % by weight. See claims 27-29. The protein compound is defined as, a vegetable protein, among others. See spec., col. 6, lines 34-44. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims from both applications are directed to compositions having overlapping limitations.

### ***Response to Arguments***

Applicant's arguments filed October 16, 2007 have been fully considered but they are not persuasive.

Applicants assert that the Fox reference is not related to the silicone grafted copolymer of the present invention. In response to applicant's arguments against the

references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Fox teaches using film forming agents with tensile strength is useful in reducing lines and wrinkles of skin, and also teaches the plant protein and skin firming agent of the instant claims. The silicone grafted copolymer of the instant claims are disclosed in Kumar, and by combining the teachings of the references a skilled artisan would have achieved the presently claimed inventions.

Applicants also assert that the present invention possess a significantly higher tensioning effect than comparative compositions and thus amounts to a surprising and unexpected results, "given the similarity of the compositions and similarity of the moieties in the polymers". Applicants' grafted copolymer is already known and used in cosmetic art. Examiner views that the finding amount to a discovery of a property of grafted silicone copolymers which is inherent to the polymers or has been suggested by a prior art reference. For example, Kumar teaches that its grafted vinyl-silicone copolymer which gives a good adhesion to a substrate and retains its hair styling property. The reference also teaches that hard monomers which make up the grafted copolymers provide tensile strength. The selection of a specific ranges of the glass transition of the copolymer in the prior art also suggests that the grafted copolymer should have an adequate shape-retention property.

### **Conclusion**

Application/Control Number:  
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Art Unit: 1617

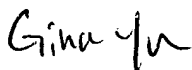
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No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 8:00AM until 5:30 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gina C. Yu  
Patent Examiner